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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,152	07/03/2001	Michael Wen-Chein Yang	POLY-1193	7052

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Woodcock Washburn Kurtz
Mackiewicz & Norris LLP
One Liberty Place - 46th Floor
Philadelphia, PA 19103

EXAMINER

HAMILTON, CYNTHIA

ART UNIT	PAPER NUMBER
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1752

13

DATE MAILED: 07/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/898,152

Applicant(s)

YANG ET AL.

Examiner

Cynthia Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-22, 25-28, 30-42, 44-45 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☒ Claim(s) 30-35, 41, 42, 44 and 45 is/are allowed.

- 6) ☒ Claim(s) 15-22, 25-28 and 36-40 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8, 11, 12. 6) ☐ Other: _____

DETAILED ACTION

1. Information Disclosure Statements

a. The information disclosure statement (IDS) submitted on May 6, 2002 (Paper # 8) was filed after the mailing date of the office action on January 15, 2002. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

b. The information disclosure statement (IDS) submitted on May 23, 2002 (Paper no. 11) was filed after the mailing date of the first action on January 15, 2002. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement. All references already considered of record as part of previous IDSs filed as Paper No. 4 and Paper No. 8 have been crossed out in this IDS and marked as already considered and duplicate citations. References marked AF, AG and AH are not these documents. Since these citations did not meet the requirements of 37 CFE 1.97 because the documents were not presented, they were crossed out. What were presented were three Derwent English abstracts and not three Chemical Abstracts. FG reference was struck from the record because no reference of such a number was part of the IDS cited by applicants nor was a copy supplied as required by 37 CFR 1.97. What was cited in the IDS noted by applicants was JP 53-023705.

c. The information disclosure statement (IDS) submitted on July 1, 2002 (paper No. 12) was filed after the mailing date of the Office Action on January 15, 2002. The

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submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

2. Claims 1-14, 23-24, 29 and 43 have been cancelled. Claims 15, 20, 27-28, 35, 40, 44 and 45 have been amended. Claims 15-22, 25-28, 30-42, 44-45 are present for examination.

Applicants have amended claims 15-22, 25-28 to require the presence of one of the listed "at least one binder " in the ablation layer wherein cellulosic polymers no longer are one of the at least one binders. Thus, the newly limited invention of claims 15-17, 21, 25-26 is not anticipated by Scott paper Company (GB 1 492 070) wherein the binder used is nitrocellulose. The newly amended invention of claims 20 and 35 requires that if a polyurethane is chosen for the "photopolymerizable layer" set forth in preceding claims that it be an acid modified acrylate polyurethane or an amine-modified acrylate polyurethane. The examiner notes that the invention of claims 20 and 35 does not exclude the selection of another included member of the list in preceding claims besides the polyurethane. Thus, the newly amended claims 20 and 35 are broader in scope than the original claims 20 and 35 because the presence of be an acid modified acrylate polyurethane or an amine-modified acrylate polyurethane is no longer required by the element defined, e. g. an element with acrylonitrile and no polyurethane at all is now within the limits of the newly amended claims 20 and 35. The examiner states this to make clear the scope of the rejections that follow.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 36-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what is meant by "the at least one binder is a polyamide" at the end of claim 36. There is no antecedent basis for "binder" in claim 30 and the limits to the "polymeric matrix" are given as a group before this binder limitation. Is this a separate limitation than the "matrix" or is it a requirement that the matrix contain two polymers? What is intended here is not clear.

6. Applicant's arguments filed May 13, 2002 have been fully considered but they are not persuasive. Applicants state that they amended claim 36 to delete the phrase "the at least one binder is a polyamide". They have not, so the rejection remains.

7. Claim 40 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention or, in the alternative, Claim 40 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The language of claim 40 requires that the dopant absorb radiation having a wavelength of 10.6 μm . Applicants cite pages 17-19 for support of this point. The examiner notes that in those pages the slip film is found ablatable at this wavelength but no statement as to the dopant causing the ablation is made. The ablation may be due to the binder used. It is unsaid here. The examiner does note that on page 9

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of the specification at lines 9-14, the "UV absorber must also exhibit a specific response to excitation by laser at an appropriate wavelength: It must allow the ablation of the slip film." It is unclear whether this statement means that the UV absorber used on pages 17-19 (the only reference to a slip layer that is IR ablatable and thus the only example of such a system) absorbs at a radiation having a wavelength of 10.6 μm or that the other components ablate at this wavelength and the UV dopant does not interfere, i.e. allows the ablation of the slip film. Does "allowing" the ablation mean absorbing at the wavelength of the absorption? The dopant Uvinol D 50 used in the sole example is cited on page 9 as being the cause of ablation at 351 nm wavelength. Thus, it is unclear whether there is support for this amendment in the original specification or if there is such a vagueness in the language that it is unclear what is meant with regard to absorbing radiation at this wavelength. The examiner also notes that if the dopant used on pages 17-19 is inherently absorbing at said wavelength and evidence is given to show its absence stops ablation of the slip layer of the example of pages 17-19, then this is sufficient evidence in the original specification to support the absorption set forth in claim 40. The issue of what part cause ablation to occur is clouded by evidence on page 4 of the specification that the polyamide suffers some thermal ablation during ablation of the slip layer with a 248 nm laser.

8. **The examiner notes** that the "one infrared absorbing material" required present in claim 15 is not exclusive of the "at least one binder" listed also as a required component. There is exclusion of one component from the other by the claim language. Thus, there is no requirement that the UV absorber of the instant specification be the infrared absorbing material of claim 15.

9. Claims 30-35, 41-42 and 44-45 are allowed.

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10. Claims 15-22 and 25-28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The process of instant claims 15- 22 and 25-28 use a photosensitive element with an ablation layer "which is ablatable by infrared aradiation and opaque to non-infrared actinic radiation". The generic group of infrared radiation ablatable layers is not originally disclosed in this application. There is a generic disclosure to laser radiation and species specific disclosure on page 18, top paragraph to a sealed - CO2 absorbing laser at 10,600 nm (10.6 um) and that a YAG laser at 1,060 nm (1.06 um) did not work. There is no disclosure to the genus of infrared ablatable layers. Further, the generic grouping of opacity to "non-infrared actinic radiation" is not found in the original disclosure and claims. The original disclosure is to a photocurable article with a UV absorbing dopant and to a UV absorbing layer. In all instances, the originaal disclosure makes use of a UV aborber. The instant process of said claims is not limited to the presence such a UV absorber. Thus, the generic film "opaque to non-infrared actinic radiation" is not originally disclosed nor is the generic process of using a film without a UV dopant found. There is no original disclosure to the presence of an ablation layer comprised of " at least one infrared absorbing material" either. The examiner believes there is insufficient support in the original claims and specification to reasonably convey to one skilled in the relevant art that the inventor(s), at the time of filing of the application had possession of the processes of instant claims 15-22 and 25-28. Applicants have presented claims more generic than the original claims. The written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species. The examiner believes

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applicants have failed to show enough IR ablatable layer species to claim the genus without a statement in the original specification to the genus. She has pointed that only one IR ablatable layer was disclosed and that one layer that was not IR ablatable under IR imaging conditions given was disclosed. Thus, the unpredictability of the chemical art of ablatable layers is demonstrated to the worker of ordinary skill in the art by applicants' disclosure which supports the examiner's stand that one species is insufficient to represent the entire genus of IR ablatable layers over all laser ablatable layers used by applicants, both UV and IR ablatable. The one species is also specific to an IR ablatable layer with a UV absorber present and a photopolymerizable layer imageable in the UV. Thus, applicants have not presented the broader generic ablatable layer where the UV absorber is not present nor another photopolymerizable layer outside the UV range, e.g. a layer polymerizable in the visible range. Applicants have not established that the original disclosure would lead a worker of ordinary skill in the art to realize only IR ablatable layers to use all the binders set forth in the original specification. The original disclosure encompassed both UV and IR ablatable layers but only under certain conditions. Applicants try to set the non working ablation example also in the IR range as evidence of a second species, but the examiner believes that this is evidence that a worker of ordinary skill in the art at the time of filing would not have concluded all the IR range and all the binders listed by applicants could be used with the UV photopolymerizable layers given. Further, there is nothing in the record that would lead workers in the art to realize applicants intended any other element other than one with a UV photopolymerizable layer was part of applicants invention. On page 6 of the instant specification, applicants state their objective is to make laser-imageable printing plates but this is already generally known in the art at the time as they have already set forth in

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the background. The next objection level set forth is "to provide a UV absorbing layer for a photocurable article that can be conveniently and accurately removed by laser ablation from the article." Thus, the issue of UV absorbing is part of the laser ablatability as part of the solution of a conveniently and accurately imageable plate from the beginning. Thus, the examiner believes a worker of ordinary skill in the art would understand this to be a limit of any plate set forth by applicants. The next step in the limits set forth by applicants is "to provide a UV absorbing and photoablatability layer for a photocurable article comprising ... polymeric matrix and ... a dopant having a high extinction coefficient in the range of 300-400 nm, the layer responding to a threshold dosage of radiation at a selected wavelength by photoablation of the polymeric matrix. Higher up on the same page of the specification applicants stated "The inventors have discovered that if a slip film, of the type already in use with flexographic plates, is modified with a strong UV absorber, a laser can be used to engrave the slip film instead of the photopolymer. Thus, applicants' invention revolves around the addition of the strong UV absorber into the ablatability film. Thus, the UV dopant is key to applicants' invention as they describe it in their specification. The examiner believes that this is sufficient evidence to make a worker of ordinary skill in the art to expect a UV absorbant to be present at all times in any element that would meet applicants disclosed invention as originally filed. Such a limit is not present in applicants' claims 15-22 and 25-28. The examiner also believes that the worker of ordinary skill in the art upon believing such a UV absorber is always present in applicants' element would also believe that the photopolymerizable layer would always have to be polymerizable in the UV range. Thus, the examiner believes that this need for UV opacity in the ablatability layer is so strongly set forth by the original specification that workers of ordinary skill

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in the art would not assume layers of opacity in other non-IR ranges such as the visible range were included. The examiner also notes that on page 8, applicants reference "It is critical that the UV absorption be nearly complete..." Thus, the original disclosure is evidence that the UV absorption is critical. This is evidence that applicants by omission of this one element raise the issue whether the applicant had possession of the broader, more generic invention. See, e.g., *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 45 USPQ2d 1498 (Fed. Cir. 1998); *Johnson Worldwide Associates v. Zebco Corp.*, 175 F.3d 985, 993, 50 USPQ2d 1607, 1613 (Fed. Cir. 1999) and MPEP 213.05. The original specification as a whole directs the worker of ordinary skill in the art to use a laser ablatable layer with the UV absorber present that would work with the accompanying UV photopolymerizable layer. The only binder disclosed useful in an IR ablatable layer is the polyamide binder used in the sole example. It is unclear whether the UV absorbant present is the agent of ablation at the IR wavelength used as already stated in the paragraph above in reference to claim 40. The issue of what part cause ablation to occur is clouded by evidence on page 4 of the specification that the polyamide suffers some thermal ablation during ablation of the slip layer with a 248 nm laser. That something cause ablation at that wavelength is clear.

11. Applicant's arguments filed May 13, 2002 have been fully considered but they are not persuasive. Applicants traverse the rejection of claims 15-22 and 25-28 under 35 USC 112, first paragraph, as lacking adequate written description "because the specification allegedly does not describe an ablation layer ablatable by infrared radiation". They state that a claimed invention not be described in *ipsis verbis* to comply with the written description requirement but that all that is required is that it reasonably convey to persons skilled in the art that, as of the filing date

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thereof, the inventor had possession of the subject matter later claimed by him. They cite *In re Edwards* as support. The examiner agrees that this is the standard to be met. Thus, the issue is whether review of the original specification and claims, as a whole, would convey to the worker of ordinary skill in the art that applicants invented what is claimed. See *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). See also MPEP 2163.02. Applicants cite *In re Smythe* to set the standard of "adequate written description" and it is "provided if a skilled artisan, upon review of a patent specification in light of the properties and features of what is described, would envision the claimed subject matter." In rendering a decision in *In re Edwards*, the court in their opinion (page 284 of 178 USPQ 279) stated, "Each case must be decided on its own facts." They also make clear on that in cases where unpredictability, such as "chemical cases", in performance of certain species or subcombinations other than those specifically enumerated, one skilled in the art may be found not to have been placed in possession of a genus or combination claimed at a later date in the prosecution of a patent application. In *Smythe*, the facts revolved around what would naturally occur to one skilled in the art from reading the description of the specification. The examiner agrees that this is the standard to be met to remove the issue of adequate description. The MPEP in 2163.02 sets forth the examiner's burden in this manner:

The subject matter of the claim need not be described literally (i.e., using the same terms or in haec verba) in order for the disclosure to satisfy the description requirement. If a claim is amended to include subject matter, limitations, or terminology not present in the application as filed, involving a departure from, addition to, or deletion from the disclosure of the application as filed, the examiner should conclude that the claimed subject matter is not described in that

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application. This conclusion will result in the rejection of the claims affected under 35

U.S.C.112, first paragraph - description requirement, or denial of the benefit of the filing date of a previously filed application, as appropriate.

Applicants have presented claims more generic than the original claims. The written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species. The examiner believes applicants have failed to show enough IR ablatable layer species to claim the genus without a statement in the original specification to the genus. She has pointed that only one IR ablatable layer was disclosed and that one layer that was not IR ablatable under IR imaging conditions given was disclosed. Thus, the unpredictability of the chemical art of ablatable layers is demonstrated to the worker of ordinary skill in the art by applicants' disclosure which supports the examiner's stand that one species is insufficient to represent the entire genus of IR ablatable layers over all laser ablatable layers used by applicants, both UV and IR ablatable. The one species is also specific to an IR ablatable layer with a UV absorber present and a photopolymerizable layer imageable in the UV and to a polyamide binder. Thus, applicants have not presented the broader generic ablatable layer where the UV absorber is not present nor another photopolymerizable layer outside the UV range, e.g. a layer polymerizable in the visible range. Applicants have not established that the original disclosure would lead a worker of ordinary skill in the art to realize only IR ablatable layers to use all the binders set forth in the original specification. The original disclosure encompassed both UV and IR ablatable layers but only under certain conditions. Applicants try to set the non working ablation example also in the IR range as evidence of a second species, but the examiner believes that this is evidence that a worker of ordinary skill in the art at the time of filing would

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not have concluded all the IR range and all the binders listed by applicants could be used with the UV photopolymerizable layers given. Further, there is nothing in the record that would lead workers in the art to realize applicants intended any other element other than one with a UV photopolymerizable layer was part of applicants invention. On page 6 of the instant specification, applicants state their objective is to make laser-imageable printing plates but this is already generally known in the art at the time as they have already set forth in the background. The next objection level set forth is "to provide a UV absorbing layer for a photocurable article that can be conveniently and accurately removed by laser ablation from the article." Thus, the issue of UV absorbing is part of the laser ablatable layer as part of the solution of a conveniently and accurately imageable plate from the beginning. Thus, the examiner believes a worker of ordinary skill in the art would understand this to be a limit of any plate set forth by applicants. The next step in the limits set forth by applicants is "to provide a UV absorbing and photoablatable layer for a photocurable article comprising ... polymeric matrix and ... a dopant having a high extinction coefficient in the range of 300-400 nm, the layer responding to a threshold dosage of radiation at a selected wavelength by photoablation of the polymeric matrix. Higher up on the same page of the specification applicants stated "The inventors have discovered that if a slip film, of the type already in use with flexographic plates, is modified with a strong UV absorber, a laser can be used to engrave the slip film instead of the photopolymer. Thus, applicants' invention revolves around the addition of the strong UV absorber into the ablatable film. Thus, the UV dopant is key to applicants' invention as they describe it in their specification. The examiner believes that this is sufficient evidence to make a worker of ordinary skill in the art to expect a UV absorbant to be present at all times in any process that

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would meet applicants disclosed invention as originally filed. Such a limit is not present in applicants' claims 15-22 and 25-28. The examiner also believes that the worker of ordinary skill in the art upon believing such a UV absorber is always present in applicants' element would also believe that the photopolymerizable layer would always have to be polymerizable in the UV range. Thus, the examiner believes that this need for UV opacity in the ablatable layer is so strongly set forth by the original specification that workers of ordinary skill in the art would not assume layers of opacity in other non-IR ranges such as the visible range were included. The examiner also notes that on page 8, applicants reference "It is critical that the UV absorption be nearly complete..." Thus, the original disclosure is evidence that the UV absorption is critical. This is evidence that applicants by omission of this one element raise the issue whether the applicant had possession of the broader, more generic invention. See, e.g., *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 45 USPQ2d 1498 (Fed. Cir. 1998); *Johnson Worldwide Associates v. Zebco Corp.*, 175 F.3d 985, 993, 50 USPQ2d 1607, 1613 (Fed. Cir. 1999) and MPEP 213.05. The original specification as a whole directs the worker of ordinary skill in the art to use a laser ablatable layer with the UV absorber present that would work with the accompanying UV photopolymerizable layer. Applicants argue that because UV absorbing layers are used and all UV absorbing layer are non infrared absorbing layers that the inclusion of all non infrared absorbing layers then one skilled in the art would have "realized that Applicants were in possession of an ablation layer that is opaque to non-infrared actinic radiation". The examiner believes that a worker of ordinary skill in the art would not leap to the broader scope of non-infrared" from the original disclosure. There is no guidance to do so and no broader language to motivate the worker to do so. Such a scope would include visible opacity which

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does not inherently flow from UV opacity. The examiner believes that the entire tenor of the original specification would not have lead workers of ordinary skill in the art to the "non-infrared" standard set forth by the instant claims. There is no broader understanding of "UV absorber" as there is for "fluid" in *In re Smythe*. There is no indication that applicants meant to encompass more than ablatable layers that had the UV absorber present or elements that were other than UV polymerizable. There are no species outside the UV photopolymerizable genus in the original specification. Applicants repeatedly argue that UV is enough support for all non-infrared radiation. The examiner believes the worker of ordinary skill in the art would not immediately see that the visible or x-ray, etc were part of applicants' original disclosure, i.e. the species given is insufficient to support claims to the genus now sought. The rejection stands for the reasons given.

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C.

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122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 15-20, 25-27 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the

alternative, under 35 U.S.C. 103(a) as obvious over Fan (6,238,837 B1). Applicants have

amended the Markush group of binder in claim 15 to exclude cellulosic binders thus removing

the issue of anticipation from the originally submitted claims. However, with respect to the use

of polyimides, polyesters, polymers of ethylene, polybutylene, polyacrylics, polyethylene,

polyphenylene ethers and polyethylene oxides, Fan in col. 9 lines 40-58 disclose their use in his

IR ablatable layers. Fan cited by applicants has a filing date of May 1, 1995 which is before the

filing date of the oldest effective date of the same application, i.e. 08/479,339 filed June 7, 1995.

However, the oldest effective filing date is June 25, 1993, drawn to a continuation - in -part of

US SN 08/082,689. The examiner had read this oldest application and found the same data

supporting an IR ablatable layer in both the current application and the oldest application. It is a

series of tests showing that the YAG laser does not ablate the instant layers but the CO2 laser

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does but only for an ablatable layer with a polyamide binder and a photopolymerizable layer identified as analogous to the "KOR" printing plates. There is no further clarification as to what is in KOR. The instant claims 15-20, 25-27 are only supported in their breadth now claimed by applicants in the amendment filed August 13, 2001. Thus, Fan is seen as prior art for the binders in these claims which are not polyamides and for the processes wherein polyamides are ablated with an Nd: YAG laser. Thus, the examples anticipate the instant processes of claims 15-20, 25-27 and in the alternative the use of any of the binders as set forth in Fan in column 9 in the IR ablatable layers set forth would have been prima facie obvious because they were taught by Fan et al as being suitable. Tan anticipates the instant process wherein butadiene-styrene block polymers are listed as one choice of binder in the photopolymerizable layer. The examiner notes that Fan does not claim a process and the element claimed by Fan is limited to the presence of a monomer as well as an elastomeric binder. However, the process of imaging with an infrared ablatable layer comprised of a binder that can be a polyamide is disclosed. In Fan, see particularly Abstract, col. 2, lines 8-10, 23-28, col. 3, lines 48-65, col. 4, lines 20-31, 55-61, col. 5, lines 65-67, col. 6, lines 1-35, col. 7, lines 55-63, col. 9, lines 10 through col. 10, lines 48, col. 12, lines 8- col. 13, lines 40 and examples and claims.

15. Applicant's arguments filed May 13, 2002 have been fully considered but they are not persuasive. Applicants argue Fan is not available as prior art because they have presented sufficient evidence in their arguments as to why the original disclosure give sufficient support to the claims with respect to the original specification that this is sufficient for the support found in SN 08/082,689 to remove Fan as a reference. The examiner has already addressed the issues of sufficiency. As to the issue of "nearly verbatim" in the parent application, the examiner has

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already addressed the failure of this disclosure to support the scope claimed by applicants. There is no support for binders other than polyamide in the original specification and there is support that YAG lasers were not supported as ablation tools for those polyamide layers. Thus, the rejection stands.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Hamilton whose telephone number is (703) 308-3626. The examiner can normally be reached on Monday-Friday, 9:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on (703) 308-2303. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305 0661.

Cynthia Hamilton
July 29, 2002



**CYNTHIA HAMILTON
PRIMARY EXAMINER**